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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,923	07/22/2003	Akira Kashiwagi	89277.0004	7123
26021	7590	10/20/2004	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/624,923	Applicant(s) KASHIWAGI, AKIRA	
	Examiner Ismael Negron	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20030722</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
6) <input type="checkbox"/> Other: _____. |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

DETAILED ACTION

Title

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: **Rear Fender Integrated Tail Lamp Device for Motorcycle.**

Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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2. The abstract of the disclosure is objected to because it repeats information given in the title, and uses phrases which can be implied. Correction is required. See MPEP § 608.01(b). The Examiner suggests deleting the first sentence of the abstract.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "15" has been used to designate both "*rear lighting device*" (page 5, line 14) and "*tail lamp device*" (page 5, line 17).

The applicant is advised that the reference characters must be properly applied, with no single reference character being used for two different parts or for a given part and a modification of such part. See MPEP §608.01(g).

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11 is indefinite as it is unclear if the claimed invention is "a tail lamp device" or "a motorcycle rear fender including a tail lamp device". While the subject matter of the invention is recited as "a tail lamp device", the body of the claim defines such device as including a section of the rear fender on which the claimed invention is defined as "mountable on". The Examiner assumed the claimed invention to be a rear fender having a tail lamp device for Prior Art rejections. Appropriate correction is required.

Claims 12 and 13 are rejected for their dependency on indefinite Claim 11.

Specification

6. The disclosure is objected to because of the following informalities: line 19 in page 4 should read:

- *"compared to a road racer type. In the motorcycle 1, a front ~~fork~~ fork 4 that rotatably".*

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-8 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by SCHWALLER et al. (U.S. Pat. 5,384,693).

SCHWALLER et al. discloses a vehicle illumination device having :

- **a tail lamp (as recited in claims 1, 5 and 14),** column 1, lines 32-35;
- **the tail lamp being attached to a rear fender (as recited in claims 1 and 5),** column 3, lines 22 and 23;
- **a lamp substrate (as recited in claims 1, 5 and 14),** Figure 1, reference number 4;
- **a plurality of light emitting elements (as recited in claims 1, 5 and 14),** Figure 1, reference numbers 2 and 3;
- **the light emitting elements being mounted on the substrate (as recited in claims 1, 5 and 14),** column 2, lines 9 and 10;
- **the substrate being disposed along a rearwardly descending surface of the fender (as recited in claims 1 and 5),** as evidenced by Figure 3, and column 3, lines 22 and 23;
- **at least one lens (as recited in claims 2, 8, 15 and 17),** Figure 3, reference number 6;

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- **the lens covering the plurality of light emitting elements (as recited in claims 2, 8, 15 and 17), column 2, lines 13-15;**
- **the lens having directivity to rearwardly direct light from the light emitting elements (as recited in claims 2, 8, 15 and 17), column 2, lines 13-15;**
- **the light emitting elements being light emitting diode (LED) elements (as recited in claims 3, 7 and 18), column 2, lines 8 and 9;**
- **the light emitting elements extending in a direction generally perpendicular to the substrate (as recited in claims 6 and 16), as seen in Figure 4;**
- **the lens directing light from the light emitting elements in a generally horizontal direction (as recited in claims 8 and 15), as evidenced by Figure 3;**
- **a housing (as recited in Claim 14), column 2, line 13;**
- **the substrate being fastened to the housing (as recite in Claim 14), column 2, lines 11-13;**
- **the substrate being tilted from the vertical line when the housing is mounted on the vehicle (as recited in Claim 14), as evidenced by Figure 3;**
- **the housing having a concave section protruding rearwardly from a bottom surface of such housing (as recited in Claim 14), as seen in Figure 3;**

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- **a circuit substrate (as recited in Claim 14), as evidenced by Figure 4;**
- **the circuit substrate being affixed to the housing below the lamp substrate (as recited in Claim 14), as evidenced by Figure 4; and**
- **the lens directing light from the light emitting elements in a generally diagonal direction (as recited in Claim 17), as seen in Figure 3.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 9-13 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHWALLER et al. (U.S. Pat. 5,384,693).

SCHWALLER et al. discloses a vehicle illumination device having :

- **a tail lamp (as recited in claims 1, 5, 11 and 14), column 1, lines 32-35;**
- **the tail lamp being attached to a rear fender (as recited in claims 1, 5 and 1), column 3, lines 22 and 23;**
- **a lamp substrate (as recited in claims 1, 5, 11 and 14), Figure 1, reference number 4;**
- **a plurality of light emitting elements (as recited in claims 1, 5, 11 and 14), Figure 1, reference numbers 2 and 3;**

- **the light emitting elements being mounted on the substrate (as recited in claims 1, 5, 11 and 14), column 2, lines 9 and 10;**
- **the substrate being disposed along a rearwardly descending surface of the fender (as recited in claims 1, 5 and 11), as evidenced by Figure 3, and column 3, lines 22 and 23;**
- **at least one lens (as recited in Claim 12), Figure 3, reference number 6;**
- **the lens covering the plurality of light emitting elements (as recited in Claim 12), column 2, lines 13-15;**
- **the lens having directivity to rearwardly direct light from the light emitting elements (as recited in Claim 12), column 2, lines 13-15;**
- **the light emitting elements being light emitting diode (LED) elements (as recited in Claim 13), column 2, lines 8 and 9;**
- **a housing (as recited in Claim 14), column 2, line 13;**
- **the substrate being fastened to the housing (as recite in Claim 14), column 2, lines 11-13;**
- **the substrate being tilted from the vertical line when the housing is mounted on the vehicle (as recited in Claim 14), as evidenced by Figure 3;**
- **the housing having a concave section protruding rearwardly from a bottom surface of such housing (as recited in claims 11 and 14), as seen in Figure 3;**

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- **a circuit substrate (as recited in claims 11, 14 and 19), as evidenced by Figure 4;**
- **the circuit substrate being affixed to the housing below the lamp substrate (as recited in claims 11 and 14), as evidenced by Figure 4;**
- **circuit elements (as recited in claims 4, 9 and 19), Figure 4, reference numbers 100 and 102;**
- **the circuit elements being for the light emitting elements (as recited in claims 4, 9 and 19), as seen in Figure 4;**
- **the circuit elements being mounted on the circuit substrate (as recited in claims 4, 9 and 19);**
- **the circuit substrate being affixed to the housing below the lamp substrate (as recited in claims 10 and 14), as evidenced by Figure 4;**
and
- **the circuit substrate being enclosed in the concave portion of the housing (as recited in Claim 20), as evidenced by figures 3 and 4.**

SCHWALLER et al. discloses all the limitations of the claims, except the rear fender having a mounting concave section for receiving the concave section of the housing (as recited in claims 4, 9 and 19).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to mount the vehicle illumination device of SCHWALLER et al. in a rear fender having a concave section for receiving the concave section of the

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illumination device to increased the aesthetic value of the rear fender and achieving a more streamlined structure.

Relevant Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Malmquist (U.S. Pat. 2,433,469), **Petty et al.** (U.S. Pat. 3,941,994), **Serizawa et al.** (U.S. Pat. 4,733,335), **Juo** (U.S. Pat. 5,526,240), **White et al.** (U.S. Pat. 5,713,653), **Zagrodnik et al.** (U.S. Pat. 6,053,626), **Bedrosian et al.** (U.S. Pat. 6,276,822), **Scherbarth** (U.S. Pat. 6,858,072) and **Ban et al.** (U.S. Pat. 6,793,384) disclose a plurality of tail lamp structures for rear fenders, most having LED light sources.

Donley (U.S. Pat. 2,343,754), **Dickson** (U.S. Pat. 3,222,512), **Iwaki** (U.S. Pat. 4,680,678), **James** (U.S. Pat. 4,858,081), **Roney** (U.S. Pat. 5,101,326), **Bodem, Jr.** (U.S. Pat. 5,388,035), **Schmid et al.** (U.S. Pat. 5,438,487) and **Roney et al.** (U.S. Pat. 5,528,474) disclosed vehicle illumination devices capable of being mounted on rear fenders, most of such devices having LED light sources.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-

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2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.


JOHN ANTHONY WARD
PRIMARY EXAMINER


Inr

October 15, 2004